APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,191	09/01/1999	MARK G. DREYER	27600/M195A	3487

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MCCRACKEN AND FRANK
200 W. ADAMS STREET
SUITE 2150
CHICAGO, IL 60606

EXAMINER
PAULA, CESAR B

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 March 2001</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-26</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-26</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

   If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____ .

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

   a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5)☐ Notice of Informal Patent Application (PTO-152)
3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5,8-9</u> .   6)☐ Other: .

DETAILED ACTION

1.   This action is responsive to the application filed on the application filed on 9/1/99, and

the IDSs filed on 4/7/00, 4/21/00, 7/21/00, 3/9/01 respectively.

This action is made Non-final.

2.   Claims 1-26 are pending in the case. Claims 1, and 16 are independent claims.

Drawings

3.   This application has been filed with informal drawings which are acceptable for

examination purposes only. Formal drawings will be required when the application is allowed.

Double Patenting

4.   The nonstatutory double patenting rejection is based on a judicially created doctrine

grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA

1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to
overcome an actual or provisional rejection based on a nonstatutory double patenting ground
provided the conflicting application or patent is shown to be commonly owned with this
application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5.   Claims 1-9, 11-13, 15-22, and 24-25 are rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claim 12 of Warmus et al,

hereinafter Warmus, U.S. Patent No. 5,963,968, 10/5/99 in view of VanderDrift, Pat. No.

5,455,945, 10/3/95.

Regarding claim 1, Warmus teaches the generation of filled out template pages from

blank templates (L.3-15).

Moreover, Warmus teaches the development of a database containing variable

information to be input into the blank template pages from blank templates (L.3-15). Warmus

fails to explicitly teach *extraction of data indicative of the portions of the first page description*

file to generate a database. However, VanDrift teaches the extraction of data to generate a

database used for the building of dynamic documents (c.2,L.10-48). It would have been obvious

to a person of ordinary skill in the art at the time of the invention to have combined the teachings

of Warmus, and VanDrift, because VanDrift teaches above the creation of a database by

extracting information from several databases and combining them into a single more efficient

database.

Regarding claim 2, which depends on claim 1, Warmus teaches the development

of the blank template pages, which include position data or placeholders for inserting variable

information to be printed (L.3-9). Warmus fails to explicitly teach *the first routine provides a*

user interface. However, it would have been obvious to a person of ordinary skill in the art at the

time of the invention to have included the user interface, because Warmus teaches above the

generation of graphical templates.

Regarding claim 4, which depends on claim 3, Warmus teaches the separation of fixed

and variable information included in the blank template pages (L.3-15). Warmus fails to

explicitly teach *page make-up software application comprises QuarkXpress.* However, it would

have been obvious to a person of ordinary skill in the art at the time of the invention to have

included QuarkXpress, because Warmus teaches above the preparation of the templates for

printing using a electronic press.

Claims 3, and 5 are directed towards a software system for implementing the software

found in claims 2, and 1 respectively, and therefore are similarly rejected.

Regarding claim 6, which depends on claim 1, Warmus teaches the development of a

database for storing blank template pages, which include position data or placeholders for

inserting, and characterizing variable information to be printed (L.3-15).

Regarding claim 7, which depends on claim 1, Warmus teaches the separation of fixed

and variable information included in the blank template pages (L.3-15). Warmus fails to

explicitly teach *a user interface for parsing each portion of the first description file to separate*

the first data portion from the second data portion. However, it would have been obvious to a

person of ordinary skill in the art at the time of the invention to have included a user interface,

because a user would be able to control the manner in which the template documents are printed,

and Warmus teaches above the preparation of the templates for printing.

Regarding claim 8, which depends on claim 7, Warmus teaches templates having fixed data, and position data for controlling a position in the templates where variable information is to be printed (L.3-15).

Regarding claim 9, which depends on claim 7, Warmus teaches the development of a blank template pages (L.3-15). Warmus fails to explicitly teach *second routine stores the first data portion of each portion in the database.* However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have stored the data in a database, because this would enable a user to store the generated templates for further use.

Regarding claim 11, which depends on claim 1, Warmus teaches the development of a database containing records with variable information to be input into the blank template pages from blank templates (L.3-15).

Regarding claim 12, which depends on claim 1, Warmus teaches the development of a database containing records with variable information to be input into the blank template pages— *image elements--* from blank templates (L.3-15). Warmus fails to explicitly teach *image file for storing image data indicative of the image element.* However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have included the templates in an image file(s), because this would enable a user to store the generated templates for further use.

Claims 13, and 15 are directed towards a software system for implementing the software found in claim 12, and 7, and therefore are similarly rejected.

Claims 16-22, 24, and 25 are directed towards a method for implementing the system found in claims 1, 3, 5-9, and 11-12 respectively, and therefore are similarly rejected.

6.   Claims 10, and 23 are rejected under the judicially created doctrine of obviousness-type

double patenting as being unpatentable over claim 12 of Warmus, in view of Mastie (Pat. #

6,480,866, 11/12/02, filed on 6/30/98).

Regarding claim 10, which depends on claim 1, Warmus teaches the generation of

template pages having fixed and variable information (L.3-15). Warmus fails to explicitly teach

the template is associated with a plurality of pages to be printed in a book. However, Mastie

teaches the printing of a plurality of pages in a book (c.4,L.14-67). It would have been obvious to

a person of ordinary skill in the art at the time of the invention to have combined the teachings of

Cohen, and Mastie, because Mastie teaches above the creation of a book onto a single document

which can be printed, stored, retrieved, etc.

Claim 23 is directed towards a method for implementing the system found in claim 10,

and therefore is similarly rejected.

7.   Claim 14, and 26 are rejected under the judicially created doctrine of obviousness-type

double patenting as being unpatentable over claim 13 of Warmus, in view of VanderDrift.

Regarding claim 14, which depends on claim 1, Warmus teaches the conversion of

templates into page sequence commands (L.1-5).

Claim 26 is directed towards a method for implementing the system found in claim 14,

and therefore is similarly rejected.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this
or a foreign country, before the invention thereof by the applicant for a patent.

9.   Claims 1-3, 5-8, 11-21, and 24-26 are rejected under 35 U.S.C. 102(a) as being

anticipated by Cohen et al, hereinafter Cohen (Pat.# 5,872,640, 2/16/99, filed 9/21/98).

Regarding independent claim 1, Cohen discloses generating a filled out template by

combining a template—*first page description file*-- and a data file (c.3,L.1-67).

Moreover, Cohen discloses an application program, such as Framemaker, for generating a

template (c.3,L.1-67).

Furthermore, Cohen discloses an application program for downloading/extraction of data

into a file for generating a filled out the template—*second page description file* (c.3,L.1-

c.4,L.67).

Regarding claim 2, which depends on claim 1, Cohen discloses generating a template

with fields or placeholders for holding data from the data file (c.1,L.52-c.2,L.11, and c.3,L.1-67).

Regarding claim 3, which depends on claim 2, Cohen discloses an application program,

such as Framemaker, for generating a template with fields or placeholders for holding data from

the data file (c.1,L.52-c.2,L.11, and c.3,L.1-67).

Claim 5 is directed towards a software system for implementing the software found in

claim 1, and therefore is similarly rejected.

Regarding claim 6, which depends on claim 1, Cohen discloses a database with a

plurality of fields, and a user generating a template with fields or placeholders for *characterizing*

data from the data file (c.1,L.52-c.2,L.11, and c.3,L.1-c.4,L.67).

Regarding claim 7, which depends on claim 1, Cohen discloses the parsing of a data file

being made up of a keyword data portion, and a data portion—*first data portion, and a second*

data portion for filling out the template (c.3,L.1-c.4,L.67).

Regarding claim 8, which depends on claim 7, Cohen discloses the inclusion of control

data, such as the template to be parsed (c.3,L.1-c.4,L.67).

Regarding claim 11, which depends on claim 1, Cohen discloses the database which

includes many templates (c.3,L.1-c.4,L.67).

Regarding claim 12, which depends on claim 1, Cohen discloses a data file for including

the name—*image element* of a template to be filled out (c.3,L.37-c.4,L.67).

Furthermore, Cohen discloses the downloading and storage of data corresponding to the

template to be filled out (c.3,L.1-c.4,L.67).

Regarding claim 13, which depends on claim 12, Cohen discloses program instructions

for populating fields, and generating a filled out template (c.3,L.37-c.4,L.67).

Regarding claim 14, which depends on claim 1, Cohen teaches a computer program to

allow a user to input or modify desired data into a data filed for the purpose of filling out the

template (c.4,L.12-c.5,L.61).

Claim 15 is directed towards a software system for implementing the software found in

claim 14, and therefore is similarly rejected.

Claims 16-21, 24-26 are directed towards a method for implementing the system found in

claims 1, 3, 5-8, 11-12, and 14 respectively, and therefore are similarly rejected.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

11.   Claims 4, 9, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen.

Regarding claim 4, which depends on claim 1, Cohen discloses generating a filled out

template by combining a template—*first page description file*-- and a data file (c.3,L.1-67).

Cohen fails to explicitly disclose: *page make-up software application comprises QuarkXPress*.

However, it would have been obvious to a person of ordinary skill in the art at the time of the

invention to have included QuarkXPress, because Cohen teaches above the implementation of

template generating software such as Adobe Framemaker.

Regarding claim 9, which depends on claim 8, Cohen discloses a database with a

plurality of fields being input by a user (c.1,L.52-c.2,L.11, and c.3,L.1-c.4,L.67). Cohen fails to

explicitly disclose: *the user interface of the second routine.* However, it would have been

obvious to a person of ordinary skill in the art at the time of the invention to have included an

user interface for inputting data into the database, because Cohen teaches above the

customization data by a user(s).

Claim 22 is directed towards a method for implementing the system found in claim 1, and therefore is similarly rejected.

12.   Claims 10, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen, in view of Mastie (Pat. # 6,480,866, 11/12/02, filed on 6/30/98).

Regarding claim 10, which depends on claim 1, Cohen discloses generating a filled out template by combining a template—*first page description file*-- and a data file (c.3,L.1-67). Cohen fails to explicitly disclose: *plurality of pages to be printed in a book.* However, Mastie teaches the printing of a plurality of pages in a book (c.4,L.14-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Cohen, and Mastie, because Mastie teaches above the creation of a book onto a single document which can be printed, stored, retrieved, etc.

Claim 23 is directed towards a method for implementing the system found in claim 10, and therefore is similarly rejected.

Conclusion

I.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gauthier (Pat. # 5,937,153), Jecha et al. (Pat. # 6,247,011), Bain, S., Fundamental QuarkXpress 4, 1998, Osborne/McGraw-Hill, p.1-20., Warmus et al. (Pat. # 6,205,452), and Lahey et al (Pat. # 6,239,802).

II.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The

examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m.

(EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at

least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should

be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

> Director United States Patent and Trademark Office
>
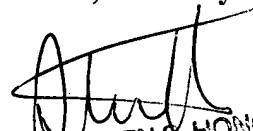> Washington, D.C. 20231

Or faxed to:

- **(703) 746-7238**, (for **After Final** communications intended for entry)

- **(703) 746-7239**, (for **Formal** communications intended for entry, **except formal After Final**

  communications)

  Or:

- **(703) 746-7240**, (for **Informal or Draft** communications for discussion only, please label

  "**PROPOSED**" or "**DRAFT**").

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Sixth Floor (Receptionist).**

CBP

STEPHEN S. HONG
PRIMARY EXAMINER

2/12/03